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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,960	11/28/2000	John Edward Cronin	IPCG-043	8198

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Attention: Aliko K. Collins, Ph.D.
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EXAMINER

DODDS, HAROLD E

ART UNIT	PAPER NUMBER
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2177

8

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/723,960

Applicant(s)

CRONIN ET AL.

Examiner

Harold E. Dodds, Jr.

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004 and 01 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 and 43-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. The formal drawings were received on 1 March 2004. These drawings are acceptable.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-8, 10-12, 43, 45, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brady et al. (U.S. Patent No. 6,463,430) and Rivette et al. (U.S. Patent No. 9,499,026).

4. Brady renders obvious independent claims 1 and 49 by the following:

"...conducting an electronic search of said first database to retrieve at least one document..." at col. 1, lines 24-27 and col. 2, lines 59-61.

"...developing a second set of fields..." at col. 8, lines 49-63 and col. 19, lines 45-47.

"...after retrieving said at least one document..." at col. 5, lines 5-8.

"...reading said at least one document to retrieve information..." at col. 1, lines 49-52 and col. 5, lines 5-8.

"...pertaining to said second set of fields..." at col. 8, lines 49-63 and col. 19, lines 45-47.

"...said second set of fields..." at col. 8, lines 49-63 and col. 19, lines 45-47.

"...and said retrieved information pertaining to said second set of fields..." at col. 5, lines 5-8, col. 8, lines 49-63, and col. 19, lines 45-47.

Brady does not teach the entering data values into fields and the use of a second database.

5. However, Rivette teaches the entering data values into fields and the use of a second database as follows:

"...and subsequently entering said at least one document into a second database..." at col. 28, lines 5-7, col. 49, lines 6-8, col. 62, lines 33-35, and col. 4, lines 11-13.

"...and subsequently entering said second set of fields into said second database..." at col. 28, lines 5-7, col. 49, lines 6-8, col. 67, lines 58-59, col. 78, lines 31-34, and col. 4, lines 11-13.

"...and subsequently entering said retrieved information into said second database..." at col. 28, lines 5-7, col. 49, lines 6-8, col. 15, lines 2-5, and col. 4, lines 11-13.

"...entering values of said first set of fields for said at least one document..." at col. 49, lines 6-8, col. 62, lines 33-35, col. 60, lines 55-58, col. 67, lines 58-59, and col. 61, lines 37-39.

"...into a second database..." at col. 4, lines 11-13.

"...and after performing the foregoing-steps..." at col. 58, lines 49-50 and col. 78, lines 35-38.

"...analyzing said information contained in said second database..." at col. 12, lines 1-5 and col. 4, lines 11-13.

It would have been obvious to one of ordinary skill at the time of the invention to combine Rivette with Brady to provide data for the fields in the database and to analyze these data in order to provide statistical summaries of information about the documents and their contents. Statistical summaries of information about the documents and their contents provide a user friendly output for a large volume of data. Furthermore, Brady and Rivette use similar systems since they teach the use of computers, the use of databases, the use of networks, the use of documents, the use of fields, the use of values, the use of information, the searching for information, the retrieval of information, the use of clients, and the use of servers. Brady provides for the search and retrieval of documents from databases and the use of fields for data and Rivette provides for values for data in the fields and analysis of information.

6. As per independent claim 47, the "...computer system including a monitor and a central processing unit..." is taught by Brady at col. 9, lines 49-52, col. 16, lines 17-18, and col. 16, lines 11-15,

the "...said computer system accessing an Internet website..." is taught by Brady at col. 9, lines 49-52 and col. 22, lines 55-17,

the "...first database..." is taught by Rivette at col. 4, lines 11-13,

the "...contained within said Internet website..." is taught by Brady at col. 22, lines 55-17,

the "...and wherein said database contains a plurality of documents..." is taught by Brady at col. 1, lines 24-27 and col. 2, lines 59-61,

the "...organized according to a first set of fields..." is taught by Brady at col. 8, lines 49-63,

the "...for an electronic search and retrieval by said computer system..." is taught by Brady at col. 1, lines 24-27 and col. 2, lines 59-61,

the "...computer instructions for conducting an electronic search of said first database to retrieve at least one document..." is taught by Brady at col. 1, lines 24-27 and col. 2, lines 59-61,

the "...computer instructions operatively configured for developing a second set of fields..." is taught by Brady at col. 8, lines 49-63 and col. 19, lines 45-47,

the "...computer instructions operatively configured for receiving extracted information pertaining to said second set of fields extracted via reading said at least one document..." is taught by Brady at col. 17, lines 60-62, col. 8, lines 49-63, and col. 19, lines 45-47,

the "...computer instructions operatively configured for entering into a second database..." is taught by Rivette at col. 4, lines 11-13,

the "...said at least one document..." is taught by Brady at col. 5, lines 5-8,
the "...after said at least one document has been retrieved from said first database..." is taught by Brady at col. 5, lines 5-8 and col. 1, lines 24-27,
values of said first set of fields for said at least one document..." is taught by Rivette at col. 49, lines 6-8, col. 62, lines 33-35, col. 60, lines 55-58, col. 67, lines 58-59, and col. 61, lines 37-39,
the "...said second set of fields and said extracted information..." is taught by Brady at col. 8, lines 49-63, col. 19, lines 45-47, and col. 4, lines 17-20,
the "...and computer instructions operatively configured for analyzing information contained in said second database..." is taught by Rivette at col. 12, lines 1-5 and col. 4, lines 11-13,
the "...as a result of said computer instructions for entering into said second database said at least one document..." is taught by Rivette at col. 49, lines 6-8, col. 4, lines 11-13, and col. 61, lines 37-39,
the "...said values of said first set of fields..." is taught by Rivette at col. 62, lines 33-35, col. 60, lines 55-58, col. 67, lines 58-59, and col. 78, lines 31-34,
the "...said second set of fields..." is taught by Rivette at col. 60, lines 55-58, col. 67, lines 58-59, and col. 78, lines 31-34,
and the "...and said extracted information..." is taught by Brady at col. 4, lines 17-20.

7. As per claim 2, the "...said first database is searched..." is taught by Rivette at col. 4, lines 11-13 and col. 1, lines 54-56

and the "...based on said first set of fields..." is taught by Rivette col. 60, lines 55-58, col. 67, lines 58-59, and col. 19, lines 20-23.

8. As per claim 3, the "...said first database is searched..." is taught by Rivette at col. 4, lines 11-13 and col. 1, lines 54-56
and the "...based on keywords..." is taught by Rivette at col. 28, lines 9-13.

9. As per claim 4, the "...said first database is searched..." is taught by Rivette at col. 4, lines 11-13 and col. 1, lines 54-56
and the "...based on a Boolean phrase..." is taught by Rivette at col. 28, lines 9-13.

10. As per claim 5, the "...said first database is searched..." is taught by Rivette at col. 4, lines 11-13 and col. 1, lines 54-56
and the "...based on a "natural language" query..." at col. 39, lines 8-11 and col. 25, lines 12-14.

11. As per claim 6, the "...said first database is a patent database..." is taught by Rivette at col. 4, lines 11-13,
the "...said documents are patents..." is taught by Rivette at col. 14, lines 23-26,
and the "...and said first set of fields are patent fields..." is taught by Rivette col. 60, lines 55-58, col. 67, lines 58-59, col. 19, lines 20-23, and col. 10, lines 63-66.

12. As per claim 7, the "...said patent database is the United States Patent and Trademark Office patent database..." is taught by Rivette at col. 2, lines 35-38 and col. 4, lines 11-13.

13. As per claim 8, the "...said patent database is the European Patent Office patent database..." is taught by Rivette at p. 3, col. 2, lines 35-37 and col. 4, lines 11-13.

14. As per claim 10, the "...said patent database is an international patent database..." is taught by Rivette at col. 4, lines 11-13 and col. 19, lines 9-20.

15. As per claim 11, the "...said patent fields are selected from a group consisting of Patent Number, Title, Assignee Name and Location, Filing date, Date of patent, Application Number, Inventor(s) Name, U.S. Class, U.S. Subclass, International Class, International Subclass, Field of Search, Number of references cited, Number of claims, Number of independent claims, Abstract, Name of Primary Examiner, Name of secondary Examiner or Name of attorney, agent, firm..." is taught by Rivette at col. 19, lines 11-20, col. 29, lines 14-16, and col. 140, lines 7-9.

16. As per claim 12, the "...said documents are publications..." is taught by Rivette at col. 61, lines 37-39 and col. 68, lines 32-36.

17. As per claim 43, the "...entering the information into a spreadsheet..." is taught by Rivette at col. 49, lines 16-18 and col. 26, lines 53-60, the "...and displaying said user-defined fields..." is taught by Rivette at col. 49, lines 16-18 and col. 19, lines 26-28, and the "...in graphs and tables..." is taught by Rivette at col. 21, lines 61-63 and col. 20, lines 64-66.

18. As per claim 45, the "...more than one documents are retrieved..." is taught by Brady at col. 1, lines 51-53.

19. As per claim 48, the "...said second database..." is taught by Rivette at col. 4, lines 11-13 and the "...is contained within said computer system..." is taught by Brady at col. 9, lines 49-52.

20. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brady and Rivette as applied to claim 6 above, and further in view of Takahashi (U.S. Patent No. 6,424,429).

As per claim 9, the "...said patent database..." is taught by Rivette at col. 4, lines 11-13, the "...patent database..." is taught by Rivette at col. 4, lines 11-13, but the "...is the Japanese Patent Office..." is not taught by either Brady or Rivette.

However, Takahashi teaches the use of the Japanese Patent Office as follows:

"...This application is based on Japanese patent applications No. HEI 9-313051, No. HEI 9-313055 and No. HEI 9-313056 filed in the Japanese Patent Office on Nov. 14, 1997, the entire contents of which are hereby incorporated by reference..." at col. 38, lines 33-37.

It would have been obvious to one of ordinary skill at the time of the invention to combine Takahashi with Brady and Rivette since Brady, Rivette, and Takahashi teach the use of computers, the use of databases, the use of networks, the use of documents, the use of values, the use of information, the searching for information, the retrieval of information, and the use of servers and Rivette and Takahashi teach the use of patents. Brady provides for the search and retrieval of documents from databases and the use of

fields for data, Rivette provides for values for data in the fields and analysis of information, and Takahashi provides for using the Japanese Patent Office.

21. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brady and Rivette as applied to claim 1 above, and further in view of Amro et al. (U.S. Patent No. 6,041,326).

As per claim 13, the "...said documents are books..." is not taught by either Brady or Rivette.

However, Amro teaches the use of books as follows:

"...The term "hypertext" was coined in the 1960s to describe documents, as presented by a computer, that express the nonlinear structure of ideas, as opposed to the linear format of books, film, and speech..." at col. 1, line 67 and col. 2, lines 1-4.

It would have been obvious to one of ordinary skill at the time of the invention to combine Amro with Brady and Rivette since Brady, Rivette, and Amro teach the use of computers, the use of databases, the use of networks, the use of documents, the use of fields, the use of values, the use of information, the searching for information, the retrieval of information, the use of clients, and the use of servers and Rivette and Amro teach the use of patents. Brady provides for the search and retrieval of documents from databases and the use of fields for data, Rivette provides for values for data in the fields and analysis of information, and Amro provides for documents such as books, newspapers, and magazines.

22. As per claim 14, the "...said documents are newspapers..." is taught by Amro at col. 1, line 67, col. 2, lines 1-4, and col. 1, lines 21-24.

23. As per claim 15, the "...said documents are magazines..." is taught by Amro at col. 1, line 67, col. 2, lines 1-4, and col. 1, lines 21-24.

24. Claims 16, 18-26, 28, 30-34, 36, 40, 41, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brady and Rivette as applied to claim 1 above, and further in view of Reed et al. (U.S. Patent No. 6,088,717).

As per claim 16, the "...said second set of fields..." is taught by Brady at col. 8, lines 49-63 and col. 19, lines 45-47,
the "...are user-defined fields..." is taught by Rivette at col. 19, lines 26-28,
but the "...and are developed from answers to questions..."
and the "...contained in a first input form..." are not taught by either Brady or Rivette.

However, Reed teaches the use of questions, the use of answers, and the use of input forms as follows:

"...Similar to the input form presented to the consumer in step 1111, this input form can contain pre-configured response options from which the provider can choose. As with consumer messages, these response options can include both internal and external data and attachments. For example, the provider could choose from a list of standard answers to frequently-asked questions that would automatically be incorporated in the provider's reply message object..." at col. 75, lines 9-17.

It would have been obvious to one of ordinary skill at the time of the invention to combine Reed with Brady and Rivette since Brady, Rivette, and Reed teach the use of computers, the use of databases, the use of networks, the use of documents, the use of fields, the use of values, the use of information, the searching for information, the retrieval of information, the use of clients, and the use of servers and Rivette and Reed teach the analysis of data. Brady provides for the search and retrieval of documents

from databases and the use of fields for data, Rivette provides for values for data in the fields and the analysis of information, and Reed provides for input forms and answers to questions.

25. As per claim 18, the "...said user-defined fields..." is taught by Rivette at col. 19, lines 26-28

and the "...comprise a technology of an invention..." is taught by Rivette at col. 1, lines 36-37 and col. 11, lines 31-35.

26. As per claim 19, the "...said user defined fields..." is taught by Rivette at col. 19, lines 26-28

and the "...comprise an element of an invention..." is taught by Rivette at col. 30, lines 53-55 and col. 11, lines 31-35.

27. As per claim 20, the "...said user defined fields..." is taught by Rivette at col. 19, lines 26-28
and the "...comprise a business driver for an invention..." is taught by Rivette at col. 11, lines 11-14.

28. As per claim 21, the "...said user defined fields..." is taught by Rivette at col. 19, lines 26-28
and the "...comprise a product of an invention..." is taught by Rivette at col. 12, lines 9-12 and col. 11, lines 31-35.

29. As per claim 22, the "...said user defined fields..." is taught by Rivette at col. 19, lines 26-28

and the "...comprise a field of an invention..." is taught by Rivette at col. 106, lines 34-36 and col. 11, lines 31-35.

30. As per claim 23, the "...said user defined fields..." is taught by Rivette at col. 19, lines 26-28,
the "...comprise a problem solved..." is taught by Brady at col. 18, lines 27-31,
and the "...by an invention..." is taught by Rivette at col. 11, lines 31-35.

31. As per claim 24, the "...said user defined fields..." is taught by Rivette at col. 19, lines 26-28
and the "...comprise an intellectual property strategy for an invention..." is taught by Rivette at col. 17, lines 20-21, col. 111, col. 49-52, and col. 11, lines 31-35.

32. As per claim 25, the "...said user defined fields..." is taught by Rivette at col. 19, lines 26-28
and the "...comprise a priority of an invention..." is taught by Rivette at col. 19, lines 11-20 and col. 11, lines 31-35.

33. As per claim 26, the "...said user defined fields..." is taught by Rivette at col. 19, lines 26-28
and the "...comprise a capability for producing an invention..." is taught by Reed at col. 98, lines 32-48 and col. 8, lines 6-10.

34. As per claim 28, the "...said user defined fields..." is taught by Rivette at col. 19, lines 26-28
and the "...comprise a market size for an invention..." is taught by Rivette at col. 98, col. 32-48 and col. 11, lines 31-35.

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35. As per claim 30, the "...said user-defined fields..." is taught by Rivette at col. 19, lines 26-28

and the "...comprise a level of importance of an invention..." is taught by Reed at col. 79, lines 24-27, col. 63, lines 49-52, and col. 8, lines 6-10.

36. As per claim 31, the "...said user-defined fields..." is taught by Rivette at col. 19, lines 26-28

and the "...comprise a patent strategy of an invention..." is taught by Rivette at col. 3, lines 22-26 and col. 11, lines 31-35.

37. As per claim 32, the "...said user-defined fields..." is taught by Rivette at col. 19, lines 26-28

and the "...comprise a business strategy of an invention..." is taught by Rivette at col. 3, lines 22-26 and col. 11, lines 31-35.

38. As per claim 33, the "...said user-defined fields..." is taught by Rivette at col. 19, lines 26-28,

the "...comprise an assessment of the ability to detect..." is taught by Rivette at col. 106, lines 31-32 and col. 71, lines 10-16,

and the "...use of an invention by anyone other than an owner of the invention..." is taught by Rivette at col. 16, lines 64-67 and col. 13, lines 20-23.

39. As per claim 34, the "...said user-defined fields..." is taught by Rivette at col. 19, lines 26-28

and the "...comprise an estimate of use of an invention by competitors..." is taught by Rivette at col. 23, lines 31-35, col. 16, lines 64-67, and col. 13, lines 20-23.

40. As per claim 36, the "...user-defined fields..." is taught by Rivette at col. 19, lines 26-28

and the "...comprise an estimate of use of an invention by customers..." is taught by Rivette at col. 23, lines 31-35 and col. 16, lines 64-67.

41. As per claim 40, the "...said user-defined fields..." is taught by Rivette at col. 19, lines 26-28

and the "...comprise an estimate of licensing potential of an invention..." is taught by Rivette at col. 12, lines 5-6 and col. 11, lines 31-35.

42. As per claim 41, the "...said user-defined fields..." is taught by Rivette at col. 19, lines 26-28

and the "...comprise an estimate of market potential of an invention..." is taught by Rivette at col. 106, lines 36-40, col. 96, lines 5-9, and col. 11, lines 31-35.

43. As per claim 46, the "...developing a high level of abstraction view..." is taught by Reed at col. 22, lines 2-4, col. 24, lines 47-51, and col. 53, lines 48-52 and the "...of said retrieved documents..." is taught by Brady at col. At col. 1, lines 51-53.

44. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brady, Rivette, and Reed as applied to claim 16 above, and further in view of Gartner et al. (U.S. Patent No. 6,438,590).

As per claim 17, the "...said user-defined fields..." is taught by Rivette at col. 19, lines 26-28,

the "...of an invention..." is taught by Rivette at col. 11, lines 31-35,

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but the "...comprise a core competency..." is not taught by either Brady, Rivette, or Reed.

However, Gartner teaches the use of core competency as follows:

"...When PNS 214 is started in step 316, PNS 214 reads one or more files 204 to obtain a description of object identifiers that the developer of media 202 could reasonably expect to already exist locally or remotely and which might be considered a core competency of the preferential naming service..." at col. 13, lines 15-20.

It would have been obvious to one of ordinary skill at the time of the invention to combine Gartner with Brady, Rivette, and Reed since Brady, Rivette, Reed, and Gartner teach the use of computers, the use of databases, the use of networks, the use of fields, the use of values, the use of information, the searching for information, the retrieval of information, the use of clients, and the use of servers and Rivette, Reed, and Gartner teach the analysis of data. Brady provides for the search and retrieval of documents from databases and the use of fields for data, Rivette provides for values for data in the fields and ant analysis of information, Reed provides for input forms and answers to questions, and Gartner provides the core competency.

45. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brady, Rivette, and Reed as applied to claim 16 above, and further in view of Steiner (U.S. Patent No. 6,311,176).

As per claim 27, the "...said user defined fields..." is taught by Rivette at col. 19, lines 26-28,

the "...of an invention..." is taught by Rivette at col. 11, lines 31-35,

but the "...comprise a level of novelty..." is not taught by either Brady, Rivette, or Reed.

However, Steiner teaches the use of a level of novelty as follows:

"...Whereas previously each patent has been examined individually against the absolute world's knowledge, an examination is now made ex officio only of the substantive accuracy of N relative relationships (means-effect), of the novelty of novel relationships, and of the level of inventiveness of the set operation, in accordance with which the instrument is always evaluated either positively or negatively as a whole..." at col. 10, lines 3-17.

It would have been obvious to one of ordinary skill at the time of the invention to combine Steiner with Brady, Rivette, and Reed since Brady, Rivette, Reed, and Steiner teach the use of computers, the use of databases, the use of networks, the use of documents, the use of information, the searching for information, and the retrieval of information. Brady provides for the search and retrieval of documents from databases and the use of fields for data, Rivette provides for values for data in the fields and an analysis of information, Reed provides for input forms and answers to questions, and Steiner provides the level of novelty.

46. Claims 29 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brady, Rivette, and Reed as applied to claim 16 above, and further in view of Aycock et al. (U.S. Patent No. 5,765,138).

As per claim 29, the "...said user defined fields..." is taught by Rivette at col. 19, lines 26-28,

the "...of an invention..." is taught by Rivette at col. 11, lines 31-35,

but the "...comprise a maturity level..." is not taught by either Brady, Rivette, or Reed,

However Aycock teaches the use of maturity levels as follows:

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"...The scaled score of the supplier responses are correlated with the relative weight of the requirements, and a supplier maturity level is calculated representing an objective evaluation of the supplier responses..." at col. 3, lines 5-9.

It would have been obvious to one of ordinary skill at the time of the invention to combine Aycock with Brady, Rivette, and Reed since Brady, Rivette, Reed, and Aycock teach the use of computers, the use of databases, the use of networks, the use of fields, the use of values, the use of documents, the use of information, the retrieval of information, and the use of servers and Rivette, Reed, and Aycock teach the analysis of information. Brady provides for the search and retrieval of documents from databases and the use of fields for data, Rivette provides for values for data in the fields and an analysis of information, Reed provides for input forms and answers to questions, and Aycock provides the maturity level and the suppliers.

47. As per claim 16, the "...said user-defined fields..." is taught by Rivette at col. 19, lines 26-28, the "...comprise an estimate of use of an invention..." is taught by Rivette at col. 23, lines 31-35 and col. 16, lines 64-67, and the "...by suppliers..." is taught by Aycock at col. 3, lines 5-9.

48. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brady, Rivette, and Reed as applied to claim 16 above, and further in view of Goldhaber et al. (U.S. Patent No. 5,855,008).

As per claim 37, the "...said user-defined fields..." is taught by Rivette at col. 19, lines 26-28, the "...comprise an estimate of..." is taught by Rivette at col. 23, lines 31-35,

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the "...generated by an invention..." is taught by Rivette at col. 4, lines 29-31,
the "...between an owner of the invention and others..." is taught by Rivette at col. 81,
lines 66-67, col. 82, line 1, and col. 16, lines 64-67,
but the "...alliance potential..." is not taught by either Brady, Rivette, or Reed.

However Goldhaber teaches the use of alliance potentials as follows:

"...This is such a fundamental change from all previous information technologies that it has the potential to transform the advertising transaction into an alliance between consumer and advertiser, based on mutual respect and mutual benefits..." at col. 3, lines 51-55.

It would have been obvious to one of ordinary skill at the time of the invention to combine Goldhaber with Brady, Rivette, and Reed since Brady, Rivette, Reed, and Goldhaber teach the use of computers, the use of databases, the use of networks, the use of values, the use of information, the searching for information, the retrieval of information, and the use of servers. Brady provides for the search and retrieval of documents from databases and the use of fields for data, Rivette provides for values for data in the fields and ant analysis of information, Reed provides for input forms and answers to questions, and Goldhaber provides the alliance potential.

49. Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brady, Rivette, and Reed as applied to claim 16 above, and further in view of Nochur et al. (U.S. Patent No. 5,835,758).

As per claim 38, the "...said user-defined fields..." is taught by Rivette at col. 19, lines 26-28,
the "...comprise an estimate of..." is taught by Rivette at col. 23, lines 31-35,

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the "...potential generated by an invention..." is taught by Rivette at col. 107, lines 62-67 and col. 4, lines 29-31,

the "...between an owner of the invention and others..." is taught by Rivette at col. 81, lines 66-67, col. 82, line 1, and col. 16, lines 64-67,

but the "...technology transfer..." is not taught by either Brady, Rivette, or Reed.

However, Nochur teaches the use of technology transfer as follows:

"...Users will have access to specific modules that will attach to provide content knowledge in specific domains such as: R&D Management, New Product Development, Technology Transfer, Mergers and Acquisitions, Fostering Innovation, Strategic Planning, Budgeting, etc..." at col. 14, lines 59-63.

It would have been obvious to one of ordinary skill at the time of the invention to combine Nochur with Brady, Rivette, and Reed since Brady, Rivette, Reed, and Nochur teach the use of computers, the use of databases, the use of networks, the use of fields, the use of values, the use of documents, the use of information, the searching for information, the retrieval of information, the use of clients, and the use of servers and Rivette, Reed, and Nochur teach the analysis of data. Brady provides for the search and retrieval of documents from databases and the use of fields for data, Rivette provides for values for data in the fields and ant analysis of information, Reed provides for input forms and answers to questions, and Nochur provides the technology transfer.

50. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brady, Rivette, and Reed as applied to claim 16 above, and further in view of Sano et al. (U.S. Patent No. 5,400,086).

As per claim 39, the "...said user-defined fields..." is taught by Rivette at col. 19, lines 26-28,
the "...generated by an invention..." is taught by Rivette at col. 4, lines 29-31,
but the "...comprise a level of prestige..." is not taught by either Brady, rivette, or Reed.

However, Sano teaches the use of levels of prestige as follows:

"...Since the above mentioned SEPP circuit is provided at a prestige of the level compensation circuit, the transistor 28 forming the SEPP circuit may include an element which is excellent in frequency characteristics rather than voltage resistance..." at col. 15, lines 33-37.

It would have been obvious to one of ordinary skill at the time of the invention to combine Sano with Brady, Rivette, and Reed since Brady, Rivette, Reed, and Sano teach the use of computers, the use of values, the use of information, and the searching for information. Brady provides for the search and retrieval of documents from databases and the use of fields for data, Rivette provides for values for data in the fields and ant analysis of information, Reed provides for input forms and answers to questions, and Sano provides the level of prestige.

51. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brady and Rivette as applied to claim 16 above, and further in view of Kableschkov (U.S. Patent No. 6,108,663).

As per claim 44, the "...each said second set of fields..." is taught by Brady at col. 8, lines 49-63 and col. 19, lines 45-47,
the "...is associated with a value..." is taught by Rivette at col. 62, lines 33-35,
the "...and said analyzing..." is taught by Rivette at col. 12, lines 1-5,

but the "...comprises summation of said values for each field..." is not taught by either Brady or Rivette.

However, Kableskov teaches the summation of values as follows:

"...Where a column-wise summation of numeric qualifying fields is required, the numeric value of the field will be stored in the buffer pending qualification, and the numeric value may then be passed to a cumulative processing unit 130, either via output bus 48, or by separate lines..." at col. 13, lines 52-56.

It would have been obvious to one of ordinary skill at the time of the invention to combine Kableskov with Brady and Rivette since Brady, Rivette, and Kableskov teach the use of computers, the use of databases, the use of networks, the use of fields, the use of values, the use of information, the search for information, the retrieval of information, the use of clients, and the use of servers and Rivette and Kableskov teach the analysis of data. Brady provides for the search and retrieval of documents from databases and the use of fields for data, Rivette provides for values for data in the fields and the analysis of information, and Kableskov provides the summation of values.

52. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brady and Rivette as applied to claim 16 above, and further in view of Blakeley et al. (U.S. Patent No. 5,761,493).

As per claim 46, the "...of said retrieved documents..." is taught by Brady at col. 2, lines 58-60, but the "...developing a high level of abstraction view..." is not taught by either Brady or Rivette.

However, Blakeley teaches developing a high level of abstraction view as follows:

"...OQL[C++] is a declarative and non-procedural language which means the programmer can take advantage of OQL[C++] to specify what data needs to be retrieved and let OQL map the higher level specification into loops that determine how to retrieve the data efficiently..." at col. 10, lines 31-34.

"It should be noted that the principle of data abstraction is strictly enforced only from the user's or application's point of view, thereby leaving open the option for OQL[C++]'s internal modules (e.g., the query optimizer) to have access to the object's representation..." at col. 10, lines 56-61.

It would have been obvious to one of ordinary skill at the time of the invention to combine Blakeley with Brady and Rivette since Brady, Rivette, and Blakeley teach the use of computers, the use of databases, the use of values, the use of information, the searching for information, and the retrieval of information. Brady provides for the search and retrieval of documents from databases and the use of fields for data, Rivette provides for values for data in the fields and the analysis of information, and Blakeley provides the high level of abstraction view.

Response to Arguments

53. Applicants' arguments filed 27 February 2004 have been fully considered but they are not persuasive. In the first argument for independent claims 1 and 49 on page 13, paragraph 4, the Applicants state:

"Regarding independent claim 1, this claim, as amended, requires, among other things, that certain steps be performed in certain sequences relative to other steps and that particular information be stored in a second database prior to the last recited step of analyzing the information contained in the second database as a result of the preceding steps. Neither Brady et al. nor Rivette et al. disclose or suggests, alone or in combination with once another, these features of amended claim 1. Furthermore,

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someone skilled in the art would not arrive at the subject matter of amended claim 1 with knowledge gained from the Brady et al. and Rivette et al. patents, knowledge common in the art or knowledge gained from any other reference of record."

The Examiner disagrees. Rivette teaches sequential processing at col. 28, lines 5-7 and processing after a series of steps at col. 58, lines 49-50 and col. 78, lines 35-38. Most procedures require some degree of sequential processing.

54. In the second argument for independent claims 1 and 49 on page 14, paragraph 2, the Applicants state:

"In addition, Brady et al. and Rivette et al., do not disclose or suggest, alone or together, the step of analyzing information in a second database, wherein that information is the particular information provided to the second database in previous steps of claim 1. This is so because neither Brady et al. nor Rivette et al. disclose or suggest entering into a second database: 1) at least one document; 2) values of a first set of fields; 3) a second set of fields; and 4) information from reading the at least one first document pertaining to the second set of fields. Again, it could be asserted that one or the other of the Brady et al. and Rivette et al. patents disclose entering such information into separate databases. However, there is nothing in these patents that discloses or suggests putting all of this information into a common database."

The Examiner disagrees. These items entered into the second database are taught by Brady and Rivette as follows:

the "...at least one document..." is taught by Rivette col. 49, lines 6-8, col. 62, lines 33-35, and col. 4, lines 11-13,

the "...values of a first set of fields..." is taught by Rivette at col. 49, lines 6-8, col. 62, lines 33-35, col. 60, lines 55-58, and col. 67, lines 58-59,

the "...second set of fields..." is taught by Rivette at col. 49, lines 6-8, col. 60, lines 55-58, and col. 67, lines 58-59,

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and the "...information from reading the at least one first document pertaining to the second set of fields..." is taught by Brady at col. 1, lines 49-52, col. 5, lines 5-8, col. 8, lines 49-63, and col. 19, lines 45-57.

55. In the third argument for independent claims 1 and 49 on page 14, paragraph 4, the Applicants state:

"The Rivette et al. patent similarly does not disclose entering all of the information of amended claim 1 into a second database. While Rivette et al. disclose various modules that a user can use to store portions of the databases anywhere the user desires, Rivette et al. do not disclose or suggest entering a number of portions, and particularly 1) at least one document, 2) values of a first set of fields, 3) a second set of fields and 4) information from reading the at least one first document pertaining to the second set of fields, into a second database as amended claim 1 requires. It is Applicants' position that any such assertion could be made only in hindsight of the present claims. This sort of hindsight in formulating an obviousness rejection is improper."

The Examiner disagrees. These items entered into the second database are taught by Brady and Rivette as follows:

the "...at least one document..." is taught by Rivette col. 49, lines 6-8, col. 62, lines 33-35, and col. 4, lines 11-13,

the "...values of a first set of fields..." is taught by Rivette at col. 49, lines 6-8, col. 62, lines 33-35, col. 60, lines 55-58, and col. 67, lines 58-59,

the "...second set of fields..." is taught by Rivette at col. 49, lines 6-8, col. 60, lines 55-58, and col. 67, lines 58-59,

and the "...information from reading the at least one first document pertaining to the second set of fields..." is taught by Brady at col. 1, lines 49-52, col. 5, lines 5-8, col. 8, lines 49-63, and col. 19, lines 45-57.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). It would have been obvious to one of ordinary skill at the time of the invention to combine Rivette with Brady to provide data for the fields in the database and to analyze these data in order to provide statistical summaries of information about the documents and their contents. Statistical summaries of information about the documents and their contents provide a user friendly output for a large volume of data.

56. In the fourth argument for claims 2-8, 10-12, 43, and 45 on page 15, paragraph 3, the Applicants state:

"Regarding dependent claims 2-8, 10-12, 43 and 45, these claims are patentable for at least the reason that they depend from amended independent claim 1, which is patentable over the cited references for the reasons discussed above."

The Examiner disagrees. Since the responses to the first three arguments render obvious independent claims 1 and 47, these claims are dependent on independent claim 1, and no additional arguments have been provided for any of these dependent claims then claims 2-8, 10-12, 43, and 45 are still rendered obvious.

57. In the fifth argument for independent claims 1 and 49 on page 15, paragraph 4, the Applicants state:

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"Regarding independent claim 47, this claim, as amended, has a number of limitations that are not disclosed or suggested by Brady et al. and Rivette et al., either alone, in combination with one another and/or in combination with other references of record or ordinary skill in the art. For example, amended claim 47 requires, among other things, computer instructions for entering 1) at least one document, 2) values of a first set of fields, 3) a second set of fields and 4) information from reading the at least one first document pertaining to the second set of fields. As discussed above relative to amended claim 1, neither Brady et al. nor Rivette et al. disclose or suggest entering such information into a second database. Likewise, neither Brady et al. nor Rivette et al. disclose or suggest computer instructions operatively configured to analyze the disparate information contained in the second database for the reasons discussed above relative to amended claim 1. Therefore, Applicants assert that claim 47, as amended, is not obvious in view of a combination of the Brady et al. and Rivette et al. patents.

The Examiner disagrees. These items entered into the second database are taught by Brady and Rivette as follows:

the "...at least one document..." is taught by Rivette col. 49, lines 6-8, col. 62, lines 33-35, and col. 4, lines 11-13,

the "...values of a first set of fields..." is taught by Rivette at col. 49, lines 6-8, col. 62, lines 33-35, col. 60, lines 55-58, and col. 67, lines 58-59,

the "...second set of fields..." is taught by Rivette at col. 49, lines 6-8, col. 60, lines 55-58, and col. 67, lines 58-59,

and the "...information from reading the at least one first document pertaining to the second set of fields..." is taught by Brady at col. 1, lines 49-52, col. 5, lines 5-8, col. 8, lines 49-63, and col. 19, lines 45-57.

Rivette teaches "analyzing said information contained in said second database" at col. 12, lines 1-5 and col. 4, lines 11-13.

58. In the sixth argument for claim 48 on page 15, paragraph 5, the Applicants state:

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"Regarding dependent claim 48, this claim is patentable for at least the reason that it depends from amended independent claim 47, which is patentable over the cited references for the reasons just discussed."

The Examiner disagrees. Since the responses to the first three arguments render obvious independent claims 1 and 47, claim 48 is dependent on independent claim 47, and no additional arguments have been provided for this dependent claim then claim 48 is still rendered obvious.

59. In the seventh argument for claim 9 on page 15, paragraph 6 and page 16, paragraphs 1 and 2, the Applicants state:

"The Examiner has rejected claim 9 under 35 U.S.C. § 103 as being obvious in view of the Brady et al. and Rivette et al. patents discussed above, and further in view of U.S. Patent No. 6,424,429 to Takahashi et al. In particular, the Examiner states that the combination of the Brady et al. and Rivette et al. patents disclose a method containing all of the elements of claim 9 except for the first database being a Japanese Patent Office (JPO) database. The Examiner then asserts that Takahashi et al. disclose a JPO database and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the JPO database with the method allegedly disclosed by Brady et al. and Rivette et al. Applicants respectfully disagree.

Claim 9 is patentable for at least the reason that it depends from amended independent claim 1, which is patentable for the reasons discussed above in connection with the obviousness-type rejection in view of the Brady et al. and Rivette et al. patents."

The Examiner disagrees. Since Rivette teaches "said patent database is the United States Patent and Trademark Office patent database" at col. 2, lines 35-38 and col. 4, lines 11-13, "said patent database is the European Patent Office patent database" at p. 3, col. 2, lines 35-37 and col. 4, lines 11-13, and "said patent database is an international patent database" at col. 4, lines 11-13 and col. 19, lines 9-20. It would have been obvious to one of ordinary skill at the time of the invention to use the Japanese Patent Office (JPO) database since like the United States Patent and Trademark Office

patent database, the European Patent Office patent database, and an international patent database, the Japanese Patent Office database contains a large number of patents, which should be referenced. Since claim 9 depends on independent claim 1 and the responses to the first three arguments have rendered obvious independent claim 1 then claim 9 is also rendered obvious.

60. In the eighth argument for claims 11-13 on page 16, paragraph 3, the Applicants state:

"The Examiner has rejected claims 13-15 under 35 U.S.C. § 103 as being obvious in view of the Brady et al. and Rivette et al. patents discussed above, and further in view of U.S. Patent No. 6,041,326 to Amro et al. In particular, the Examiner states that the combination of the Brady et al. and Rivette et al. patents disclose a method containing all of the elements of these claims except for the documents being books, newspapers and magazines. The Examiner then asserts that Anuo et al. disclose books, newspapers and magazines and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the method allegedly disclosed by Brady et al. and Rivette et al. in connection with books, newspapers and magazines. Applicants respectfully disagree. Claims 13-15 are patentable for at least the reason that each depends from amended independent claim 1, which is patentable for the reasons discussed above in connection with the obviousness-type rejection in view of the Brady et al. and Rivette et al. patents."

The Examiner disagrees. Amro teaches "said documents are books" at col. 1, line 67 and col. 2, lines 1-4, "said documents are newspapers" at col. 1, line 67, col. 2, lines 1-4, and col. 1, lines 21-24 and "said documents are magazines" is taught by Amro at col. 1, line 67, col. 2, lines 1-4, and col. 1, lines 21-24. Since claims 11-13 depend on independent claim 1 and the responses to the first three arguments have rendered obvious independent claim 1 then claims 11-13 are also rendered obvious.

61. In the ninth argument for claims 16, 18-26, 28, 30-34, 36, 40, 41 and 46 on page 16, paragraph 5 and page 17, paragraph 1, the Applicants state:

"The Examiner has rejected claims 16, 18-26, 28, 30-34, 36, 40, 41 and 46 under 35 U.S.C. § 103 as being obvious in view of the Brady et al. and Rivette et al. patents discussed above, and further in view of U.S. Patent No. 6,088,717 to Reed et al. In particular, the Examiner states that the combination of the Brady et al. and Rivette et al. patents disclose a method containing all of the elements of these claims except for certain features, e.g., developing answers to questions contained in a first input form. The Examiner then asserts that Reed et al. disclose these features and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the features disclosed by Reed et al. in the method allegedly disclosed by Brady et al. and Rivette et al. Applicants respectfully disagree."

The Examiner disagrees. In independent claim 1, the independent claim upon which claim 16 depends, Brady teaches "conducting an electronic search of said first database to retrieve at least one document" at col. 1, lines 24-27 and col. 2, lines 59-61. Nowhere in independent claim 1 is a method described, which defines who or what determines the documents to be retrieved. A person of ordinary skill at the time of the invention would have depended upon user input to define which class of documents would be retrieved. Thus, an input form presented to the user could contain pre-configured response options from which the provider could choose in order to specify what documents are to be retrieved.

62. In the tenth argument for claims 16, 18-26, 28, 30-34, 36, 40, 41 and 46 on page 17, paragraph 4, the Applicants state:

"In contrast, the present invention is directed to a method and system for analyzing one or more documents and other information extracted from and/or relating to the one or more documents. One part of the method is to retrieve and read at least one document to retrieve information pertaining to a second set of fields. In one embodiment, the second set of fields are user-defined fields developed from answers to questions contained in a first input form. This is the subject matter of dependent claim 16, which depends directly from amended dependent claim 1."

The Examiner disagrees. Claim 16 is taught by a combination of references from Brady, Rivette, and Reed. Brady teaches "said second set of fields" at col. 8, lines 49-63 and

col. 19, lines 45-47, Rivette teaches "are user-defined fields" at col. 19, lines 26-28, and Reed teaches "and are developed from answers to questions contained in a first input form" at col. 75, lines 9-17. Likewise, since claim 16 depends on independent claim 1 and the responses to the first three arguments have rendered obvious independent claim 1 then claim 16 is also rendered obvious.

63. In the eleventh argument for claims 16, 18-26, 28, 30-34, 36, 40, 41 and 46 on page 17, paragraph 5 and page 18, paragraph 1, the Applicants state:

"In addition to claim 16 being patentable over the references of record by virtue of its dependence upon amended claim 1, which is patentable for the reasons discussed above, claim 16 is also patentable due to its own subject matter. That is, Applicants believe that, although Reed et al. disclose the use of forms in one context, i.e., on-line technical support for software, the Reed et al. disclosure does not render obvious the use of forms in claim 16, which is directed to a completely different context. It cannot fairly be said that the Reed et al. two-way communication use of forms render obvious the first forms of claim 16 that are used for developing a second set of user-defined fields that are subsequently entered into a second database and thereafter analyzed (see amended claim 1). In addition, neither Brady et al. nor Rivette et al. provide any suggestion to make the combination with the Reed et al. patent, nor would anyone skilled in the art be motivated to make the combination, at least without hindsight of the present claims.

The Examiner disagrees. Since claim 16 depends on independent claim 1 and the responses to the first three arguments have rendered obvious independent claim 1 then claim 16 is also rendered obvious. In independent claim 1, the independent claim upon which claim 16 depends, Brady teaches "conducting an electronic search of said first database to retrieve at least one document" at col. 1, lines 24-27 and col. 2, lines 59-61. Nowhere in independent claim 1 is a method described, which defines who or what determines the documents to be retrieved. A person of ordinary skill at the time of the invention would have depended upon user input to define which class of documents

would be retrieved. Thus, an input form presented to the user could contain pre-configured response options from which the provider could choose in order to specify what documents are to be retrieved.

64. In the twelfth argument for claims 16, 18-26, 28, 30-34, 36, 40, 41 and 46 on page 18, paragraph 2, the Applicants state:

"In view of the foregoing, Applicants respectfully assert that the cited combination of the Brady et al., Rivette et al. and Reed et al. patents do not render dependent claim 16, nor claims 18-26, 28, 30-34, 36, 40 and 41 that depend therefrom, obvious. In addition, Applicants believe claims 18-26, 28, 30-34, 36, 40 and 41 contain subject matter that is separately not obvious in view of the combination. However, Applicants defer arguing the rejection of these claims because of the clear patentability of claim 16, but reserve the right to do so if the need arises in a future Office Action."

The Examiner disagrees. Since claim 16 depends on independent claim 1 and the responses to the first three arguments have rendered obvious independent claim 1, claims 18-26, 28, 30-34, 36, 40, and 41 depend on claim 16 and the responses to the ninth, tenth, and eleventh arguments have additionally shown that claim 16 is rendered obvious, and no additional arguments have been provided to any of claims 18-26, 28, 30-34, 36, 40, and 41, then these dependent claims are also rendered obvious.

65. In the thirteenth argument for claims 16, 18-26, 28, 30-34, 36, 40, 41 and 46 on page 18, paragraph 3, the Applicants state:

"Regarding dependent claim 46, this claim requires the additional step of developing a high level of abstraction view of a plurality of documents. Reed et al. simply do not disclose or suggest such a step. Reed et al. do use the term "abstraction" However, they use this term to describe the object-oriented architecture of their system. This has nothing whatsoever to do with developing a high level of abstraction view of a plurality of documents. Therefore, Applicants assert that the Examiner made the present rejection in hindsight of claim 46 and that claim 46 is not obvious in view of the asserted combination."

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The Examiner disagrees. In independent claim 1, Rivette teaches "analyzing said information contained in said second database" at col. 12, lines 1-5 and col. 4, lines 11-13. One of the purposes of such an analysis would surely be to provide an overview or summary of the documents retrieved. A person of ordinary skill at the time of the invention would have used a summary such as a high level of abstraction view in order to present the user with a meaningful summary of the documents retrieved and thus make to system more user friendly.

66. In the fourteenth argument for claims 17, 27, 29, 35, and 37-39 on page 18, paragraph 4 and page 19, paragraph 1, the Applicants state:

"The Examiner has rejected claims 17, 27, 29, 35 and 37-39 under 35 U.S.C. § 103 in view of respective combinations of the Brady et al./Rivette et al./Reed et al. trio with each of U.S. Patent No. 6,438,590 to Gartner et al., U.S. Patent No. 6,311,176 to Steiner, U.S. Patent No. 5,765,138 to Aycock et al., U.S. Patent No. 5,855,008 to Goldhaber et al., U.S. Patent No. 5,835,758 to Nochur et al. and U.S. Patent No. 5,400,086 to Sano et al. Each of these claims depends from claim 16, which is patentable over the references of record for the reasons discussed above in connection with the rejection of claim 16. In addition, Applicants believe claims 17, 27, 29, 35 and 37-39 contain subject matter that is separately not obvious in view of the combination. However, Applicants defer arguing the rejection of these claims because the clear patentability of claim 16, but reserve the right to do so if the need arises in a future Office Action."

The Examiner disagrees. Since claim 16 depends on independent claim 1 and the responses to the first three arguments have rendered obvious independent claim 1, claims 17, 27, 29, 35, and 37-39 depend on claim 16 and the responses to the ninth, tenth, and eleventh arguments have additionally shown that claim 16 is rendered obvious, and no additional arguments have been provided to any of claims 17, 27, 29, 35, and 37-39 then these dependent claims are also rendered obvious.

67. In the fifteenth argument for claim 42 on page 19, paragraphs 2 and 3, the Applicants state:

"The Examiner has rejected claim 42 under 35 U.S.C. § 103 as being obvious in view of the Brady et al. and Rivette et al. patents discussed above in connection with the rejection of claim 1, above, and farther in view of U.S. Patent No. 6,618,709 to Sneeringer. In particular, the Examiner states that the combination of the Brady et al. and Rivette et al. patents disclose a method containing all of the elements of this claim except for a Microsoft Access® database. The Examiner then asserts that Sneeringer discloses a Microsoft Access® database and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the Microsoft Access® database in the method allegedly disclosed by Brady et al and Rivette et al.

Applicants have canceled claim 42. Therefore, the present rejection is moot."

The Examiner partially agrees. Since the Applicants have cancelled claim 42 the fifteenth argument about this claim is moot.

68. In the sixteenth argument for claim 44 on page 19, paragraphs 4 and 5 and page 20, paragraph 1, the Applicants state:

"The Examiner has rejected claim 44 under 35 U.S.C. § 103 as being obvious in view of the Brady et al. and Rivette et al. patents discussed above, and further in view of U.S. Patent No. 6,108,663 to Kablesbkov. In particular, the Examiner states that the combination of the Brady et al. and Rivette et al. patents disclose a method containing all of the elements of claim 44 except for the step of summing values in a second set of fields. The Examiner then asserts that Kablesbkov discloses this summation step and further asserts that it would have been obvious to a person having ordinary skill in the art at the tune of the invention to utilize the summation step disclosed by Kablesbkov in the method allegedly disclosed by Brady et al., and Rivette et al. Applicants respectfully disagree.

In making the present rejection, the Examiner states that Brady et al. disclose a second set of fields, Rivette et al. teach the elements of "is associated with a value" and analyzing, and Kablesbkov teaches summing values and then asserts that claim 44, which requires summing values associated with a second set of fields, is obvious. Applicants assert that the Examiner is taking the limitation of claim 44 out of its proper context relative to amended independent claim 1 from which claim 44 depends. In its proper context, claim 44 requires not only the summation of values associated with a second set of fields, but rather values that are extracted from reading at least one

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document retrieved from a first database and stored in a second database, along with the value associated with the second set of fields. None of the Brady et al., Rivette et al. and Kableskov patents, alone, in combination with one another or in combination with any references of record or ordinary skill in the art, disclose or suggest all of the features of claim 44 as it depends from claim I. Accordingly, Applicants assert that the cited combination has been made in hindsight of claim 44 and does not render claim 44 obvious."

The Examiner disagrees. Brady, Rivette, and Kableskov teach dependent claim 44 as follows: Brady teaches "each said second set of fields" at col. 8, lines 49-63 and col. 19, lines 45-47, Rivette teaches "is associated with a value" at col. 62, lines 33-35 and "and said analyzing" is taught by Rivette at col. 12, lines 1-5, and Kableskov teaches "comprises summation of said values for each field" at col. 15, lines 33-37. In independent claim 1, Rivette teaches "analyzing said information contained in said second database" at col. 12, lines 1-5 and col. 4, lines 11-13. One of the purposes of such an analysis would surely be to provide an overview or summary of the documents retrieved. A person of ordinary skill at the time of the invention would have used a summation of values in the data fields in order to present the user with a meaningful summary of the documents retrieved and thus make to system more user friendly.

69. In the seventeenth argument for claim 46 on page 20, paragraph 1, the Applicants state:

"The Examiner has rejected claim 46 under 35 U.S.C. § 103 as being obvious in view of the Brady et al. and Rivette et al. patents discussed above, and further in view of U. S. Patent No. 5,761,493 to Blakely et al. In particular, the Examiner states that the combination of the Brady et al. and Rivette et al. patents disclose a method containing all of the elements of these claims except for the step of developing a high level of abstraction view. The Examiner then asserts that Blakely et al. disclose developing a high level of abstraction view and further asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize this step disclosed by Blakely et al. in the method allegedly disclosed by Brady et al and Rivette et al. Applicants respectfully disagree.

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Like the Reed et al. patent discussed above relative to the rejection of claim 46, the Blakely et al. patent includes the term "abstraction" in the context of describing object-oriented data structures. However, claim 46 requires the step of developing a high level of abstraction view of a plurality of documents. Blakely et al. simply do not disclose or suggest such a step. The use of the term "abstraction" by Blakely et al. has nothing whatsoever to do with developing a high level of abstraction view of a plurality of documents. Therefore, Applicants asserts that the Examiner made the present rejection in hindsight of claim 46 and that claim 46 is not obvious in view of the asserted combination. In view of the foregoing, Applicants respectfully request that the Examiner withdraw all of the rejections made under 35 U.S.C. § 103.

The Examiner disagrees. Brady and Blakely teach dependent claim 46. Blakely teaches "developing a high level of abstraction view" at col. 10, lines 31-34 and col. 10, lines 56-61 and Brady teaches "of said retrieved documents" at col. 2, lines 58-60. In independent claim 1, Rivette teaches "analyzing said information contained in said second database" at col. 12, lines 1-5 and col. 4, lines 11-13. One of the purposes of such an analysis would surely be to provide an overview or summary of the documents retrieved. A person of ordinary skill at the time of the invention would have used a summary such as a high level of abstraction view in order to present the user with a meaningful summary of the documents retrieved and thus make to system more user friendly.

70. In the eighteenth argument for claim 49 on page 21, paragraph 1, the Applicants state:

'New claim 49 is a structure claim directed to a computer readable storage medium containing a computer program for performing the method of amended claim 1. Accordingly, Applicants assert that claim 49 is patentable for essentially the same reasons that amended claim 1 is patentable.'

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The Examiner disagrees. Since independent claim 49 has the same elements as independent claim 1 and the responses to the first three arguments render obvious independent claim 1 then independent claim 49 is also rendered obvious.

Conclusion

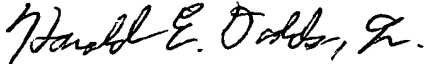
71. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

72. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harold E. Dodds, Jr. whose telephone number is (703)-305-1802. The examiner can normally be reached on Monday - Friday 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703)-305-9790. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Harold E. Dodds, Jr.
Patent Examiner
May 17, 2004


GRETA ROBINSON
PRIMARY EXAMINER